

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN F. CORSON

Appeal 2006-2996
Application 10/066,157
Technology Center 1700

Decided: September 28, 2006

Before WARREN, WALTZ, and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the Examiner finally rejecting claims 15 through 21, 27, 29, 30, and 33 through 48, all of the claims in the application.

Claim 15 illustrates Appellant's invention of a method using a chemical array reader, and is representative of the claims on appeal:

15. A method using a chemical array reader having
 - i) a holder to mount an array and hold the array at a reading position:

ii) a light system to illuminate a mounted array when at a reading position;

iii) a detection system having a focal plane, to detect light from different regions across the array emitted in response to the illumination, when at the reading position, and which generates a resulting signal for each of the regions across the array; and

iv) an autofocus system which detects and reduces offset between the different regions of an array at the reading position and a determined position of the focal plane;

the method comprising:

a) positioning a calibration member having a uniform fluorescent layer at the reading position so as to receive illumination from the light system and emit light in response thereto, which emitted light is detected by the detection system to generate a resulting calibration signal;

b) adjusting a position of the calibration member, when in the reading position, relative to the focal plane;

c) determining the position of the focal plane from the light detected at various adjustments; and

d) calibrating a sensitivity of the detection system from the detection system signals generated from the calibration member.

The references relied on by the Examiner are:

King	US 5,812,272	Sep. 22, 1998
Overbeck	WO 99/47964	Sep. 23, 1999

The Examiner has rejected appealed claims 15 through 21, 27, 29, 30, and 33 through 37, 39 through 45, 47, and 48 under 35 U.S.C. § 103(a) as being unpatentable over Overbeck (Answer 3-6), and claims 38 and 46 under 35 U.S.C. § 103(a) as being unpatentable over Overbeck in view of King (*id.* 6)

We reverse.

We refer to the Answer and to the Brief and Reply Brief for a complete exposition of the positions advanced by the Examiner and Appellant.

OPINION

The dispositive issue in this appeal is whether steps a) through c) of the claimed method encompassed by claim 15 and the same method steps couched in essentially the same language in appealed independent claim 39 can be reasonably interpreted as encompassing step d) of the claimed method encompassed by claim 15 and similarly in claim 39. We interpret the language of these claims by giving the terms thereof the broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art in light of the written description in the specification, including the drawings, unless another meaning is intended by appellant as established in the written description of the specification, and without reading into the claims any limitation or particular embodiment disclosed in the specification. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

We agree with Appellant that when the plain language of claims 15 and 39 is considered in light of the disclosure in the written description in the specification, the step of “calibrating a sensitivity of the detection system” is indeed separate from the steps specified for determining the position of the focal plane with the use of a calibration member, even

though the step of “calibrating a sensitivity of the detection system” uses “the detection system signals generated from the calibration member” in calibrating the position of the focal plane (Reply Br. 2-4; specification 14:29 to 16:3 and **FIGs. 5-8**; see Answer 6-8).

Accordingly, in the absence of a prima facie case of obviousness based on all of limitations specified for the claimed methods of using a chemical array reader encompassed by claim 15 and claim 39, and claims dependent thereon, respectively, we reverse the grounds of rejection under 35 U.S.C. § 103(a).

The Examiner’s decision is reversed.

REVERSED

sld

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